application was filed, had possession of the claimed invention. Thus, the Office Action asserts that the recitation of a "substantially rigid" metal pipe is not supported by the original disclosure and the claims contain new matter. Applicant respectfully disagrees and traverses the rejection.

The specification discloses, for example, a main shield portion 51 made of a metal pipe. See at least page 13, lines 11-12. As described, if the two ends of the main shield portion 51 are fixed directly to two shield cases 11 and 21, stresses may be generated at the fixed portions due to vibrations thereof. See page 13, lines 12-15. This is due to the substantially rigid nature of the metal pipe. Therefore, the specification teaches forming a flexible sub-shield portion 53 to absorb the vibrations of the main shield portion 51. See page 13, lines 15-17. Because the sub-shield portion 53 is flexible, the stresses that would occur at the connections to the shield cases 11 and 21 if the main shield portion 51 is directly connected thereto may be avoided/reduced. See page 13, lines 15-19.

Thus, based on the specification, one of ordinary skill in the art would understand that main shield portion 51 is substantially rigid. If the main shield portion 51 was not made of a substantially rigid metal material, there would be no need to introduce a flexible sub-shield portion 53 between the main shield portion 51 and the shield cases 11 and 21 because the vibrations would be absorbed/reduced by the main shield portion 51 itself.

If the main shield portion 51 was flexible, providing a flexible sub-shield portion 53 would not serve the purpose specifically described in the specification. Therefore, the specification provides ample description of the subject matter of the pending claims, such that one of ordinary skill in the art would be well aware that Applicant was in possession of "a main shield portion made of a substantially rigid metal pipe" at the time of filing.

The modifier "substantially rigid" is inherent in the description provided by the specification, and thus is not new matter. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under 35 U.S.C. §103(a)

A. AOAPA in view of Morgan

The Office Action rejects claims 1-3, 5 and 6 under 35 U.S.C. §103(a) over Applicant's Own Admission of Prior Art ("AOAPA") in view of U.S. Patent No. 5,473,117 to Morgan et al. ("Morgan"). Applicant respectfully traverses the rejection.

The AOAPA does not teach or suggest a shielded wire harness including a shielding member having "a main shield portion made of a substantially rigid metal pipe," as recited in claim 1.

The Office Action admits that the AOAPA does not teach or suggest a shielding member formed in the tube shape, configured to enclose a plurality of wires collectively, connected to a shield case, including a main shield portion made of a substantially rigid metal pipe, and including a sub-shield portion. However, the Office Action asserts that Morgan remedies the deficiencies of the AOAPA. Notwithstanding these assertions, Morgan does not remedy the deficiencies of the AOAPA. Specifically, Morgan does not teach or suggest a main shield portion made of a substantially rigid metal pipe, as set forth in claim 1.

Morgan teaches a cable 10 have a plurality of conductors 18 collectively enclosed by a foil inner shield 16 and a foil outer shield 14 folded around an external shape of a bundle of the conductors 18. See col. 2, line 67 - col. 3, line 8. See Figs. 1 and 2. Morgan also teaches that the outer shield 14 is cut and folded back to expose a conductive inner surface to provide electrical contact with the ground strap assembly 24. See col. 3, lines 31-47, col. 6, lines 10-13, and Fig. 2. Further, both the outer shield 14 and the inner shield 16 consist of

foil shielding of the type widely used in the electronic industry for cable shielding. See col. 3, lines 4-6.

A person of ordinary skill in the art of cable shielding would understand and recognize that the foil shields of Morgan are not substantially rigid. A foil, by definition, is a very thin sheet of metal. Such very thin sheets of metal, such as aluminum foil, are inherently flexible and non-rigid. Such foils are well suited for shielding layers because such layers serve only to block electrical noise and typically are surrounded by an insulative casing, e.g., coaxial cable. The flexible nature of such shielding foils allows the cable to retain its desired flexibility. When making connections with a cable that includes such shielding foils, it is well known that the foil is easily cut, deformed and/or stripped to add a connector to the cable.

Morgan itself specifically discloses that by bending the large cable 10 to form a curve with a tight radius, the shielding materials 14, 16 surrounding the conductors 18 often tear. See col. 1, lines 16-18. Thus, the outer shield 14 and the inner shield 16 are thin, flexible pieces of material that can be easily torn or deformed. Further, Morgan teaches that the foil outer and inner shields 14, 16 are pliable, so they may be cut and folded back to expose a conductive inner surface to provide electrical contact. See col. 3, lines 31-47, col. 6, lines 10-13, and Fig. 2.

Therefore, it is respectfully submitted that the shielding materials 14, 16 cannot reasonably be considered to be "substantially rigid" as alleged by the Office Action.

The Office Action alleges that the metallic sheet forming the shield would inherently be substantially rigid because metallic sheets forming shields are commonly utilized as shields. As discussed above, this is not true.

MPEP §2112 states the following:

> The fact that a certain result characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.
>
> In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied prior art.

The Office Action fails to provide a basis in fact and/or technical reasoning to support the allegation that "substantial rigid" is an inherent characteristic that necessarily flows from the teachings of either AOAPA or Morgan. The Office Action merely alleges that metallic sheets forming shields are commonly utilized as a shield. However, as discussed above, use as an electrical shield does not require substantial rigidity. As commonly used, electrical shields are flexible, not rigid. Thus, the Office Action fails to support the allegation of inherency.

For at least these reasons, Morgan, like the AOAPA, does not teach or suggest a main shield portion made of a substantially rigid metal pipe.

Therefore, claim 1 would not have been rendered obvious by the AOAPA in view of Morgan. Claims 2, 3, 5 and 6 depend from claim 1, and thus also would not have been rendered obvious by the AOAPA in view of Morgan. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. The AOAPA in view of Morgan, and further in view of Lawson

The Office Action rejects claim 4 under 35 U.S.C. §103(a) over the AOAPA in view of Morgan, and further in view of U.S. Patent No. 3,280,246 to Lawson et al. ("Lawson"). Applicant respectfully traverses the rejection.

As discussed above, neither the AOAPA nor Morgan, alone or in combination, teaches or suggests a shielded wire harness including a shielding member having "a main shield portion made of a substantially rigid metal pipe," as recited in claim 1. Lawson does not remedy the deficiencies of the AOAPA and Morgan.

Lawson is directed to a ground shield connector 10 including a tinned soft copper compression ring 20 fitted over a tinned brass collector ring 18 to hold all end portions 26 of metallic shieldings (braided portions) of each wire conductor 12. See Figs. 2 and 4, and col. 2, line 56 – col. 3, line 40. Lawson does not teach or suggest that the compression ring 20 or the collector ring 18 is a substantially rigid metal pipe. For at least these reasons, and the reasons previously set forth in the September 15 Amendment, Lawson, like the AOAPA and Morgan, does not teach or suggest a main shield portion made of a substantially rigid metal pipe.

Claim 4 depends from claim 1, and thus would not have been rendered obvious by the AOAPA in view of Morgan, and further in view of Lawson. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-6 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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